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10/597,783	08/08/2006	Gaetano Bergami	242/9-2277	6304

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EXAMINER

TURNER, SONJI LUCAS

ART UNIT	PAPER NUMBER
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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,783	Applicant(s) BERGAMI, GAETANO	
	Examiner SONJI TURNER	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. Claims 1-18 have been cancelled. Claims 19-36 are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) filed October 27, 2008 is acknowledged and has been placed in the application file.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation in new claim 19 at lines 3 and 4 for “the filtering element . . . so as to surround a lower air inlet opening (9)” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. The drawings are objected to because figures should be labeled/numbered and presented from top to bottom and/or left to right (i.e., fig. 1 should be presented to the left of fig. 2 on the left side of the page).
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because
 - a. Reference characters “2” and “3” have both been used to designate “filtering element,”
 - b. Reference characters “14” and “15” have both been used to designate “fixing means,”
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because
 - c. Reference character “2” has been used to designate both “filtering element” and “tubular case.”

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d. Reference character “14” has been used to designate both “recess” and “fixing means.”

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description(page 4, line 6): “seat 13.”

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The disclosure is objected to because of the following informalities:

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e. Brief description of figure 2 on page 2 is ambiguous. If figure 2 is a cross-section of figure 1 is an accurate understanding, consider rewriting and including a direction line in figure 1 showing division of the longitudinal plan for the specific section in figure 1.

f. Page 3 line 23 delete “ogive” and replace with –to give—.

Appropriate correction is required.

Claim Objections

9. Claim 19 is objected to because of the following informalities:

g. Applicant use of “an interior volume of the tubular case” (line 8) and “an inner volume of the tubular case” (line 11). Although interior and inner are used interchangeable, select one or the other for consistency to avoid ambiguity.

h. “the inlet opening (5)” should read –an inlet opening (5)—

Appropriate correction is required.

Claim 35 is objected to because of the following informalities:

i. Insert –tubular— between “trumpet” and “shaped” in line 2.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The limitation in claim 19 at lines 3 and 4 for “the filtering element . . . so as to surround a lower air inlet opening (9)” and at lines 8 and 9 for “a trapping zone” are not taught or disclosed in the specification. Additionally, the drawings do not show the feature of the filtering element surrounding a lower air inlet opening (9) either nor label a trapping zone.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the inlet opening (5)" in line 14 and the limitation "the inner volume of the tubular casing" in line 16.

Claim 19 recites the limitation "defining a trapping zone between an inward end of the trumpet shaped tubular body and the outlet means (8)" in lines 8 and 9. The “outlet means (8) is defined at page 3, lines 10-19 is understood as”. . . shaped as the trumpet outlet.” As such, the boundaries for “a trapping zone” recited in claim 19 are not clear.

Claim 35 the limitation "the trumpet shaped body (11)" in line 2.

13. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

14. Claims 19-21, 23-27, and 29-34 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bergami ‘852 (WO 01/43852). Bergami ‘852 teaches each limitation essentially as recited for claims 1-3, 5-9, and 11-16. See page 3, lines 24-31; page 4; page 5, lines 1-8; page 7; page 8, lines 23-32; page 9, lines 1-2; fig.1; abstract.

Claim Rejections - 35 USC § 103

15. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergami '852. Bergami '852 teaches each of the limitations recited in independent claim 19. The shape and/or configuration of the tubular body where it is narrowed toward inside the air filter device and the shape of the tubular case as an elliptic or oval section is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the device was significant. See MPEP 2144.04.

16. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergami '852 as applied to claim 1 above, and further in view of Dudrey '949 (US Patent 5,669,949). Bergami '852 teaches the limitations recited in claim 19 but does not teach a spacer mean that matches the inside wall of the tubular case. Dudrey '949 teaches an air filtration arrangement with spacers (12), see fig. 1; col. 9, lines 5-8. It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include the spacers of Dudrey '949 for the purpose of maintaining the filter in a desired position within the housing. One skilled in the art would have been motivated to generate the claimed invention with a reasonable expectation of success.

Response to Remarks

17. Applicant's remarks filed November 25, 2008 have been fully considered but they are not persuasive. Please see the above sections. Regarding remarks at page 6, the citation of "(See spec. pg. 4, line 28-31, . . .)" for the illustration is a discussion for the deflecting means 6 in the filtering element 3 and not for a trapping zone. The reference to "a sort of trap fit" found on page 5, line 2 does not define bounds in the recitation for a trapping zone as recited in claim 19.

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The nonstatutory double patenting rejection of claims 1, 12, 15, and 16 has been withdrawn, as these claims are cancelled.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonji Turner whose telephone number is 571-272-1203. The examiner can normally be reached on Monday - Friday, 10:00 am – 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

st

03/11/2009

/DUANE SMITH/
Supervisory Patent Examiner, Art Unit 1797